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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,746	07/21/2003	Eric L. Andersen	100202636-1	7520

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EXAMINER

DULANEY, BENJAMIN O

ART UNIT	PAPER NUMBER
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2625

NOTIFICATION DATE	DELIVERY MODE
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12/24/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/623,746	Applicant(s) ANDERSEN ET AL.	
	Examiner BENJAMIN O. DULANEY	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,9,10,13-16,19,20 and 27-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,9,10,13-16,19,20 and 27-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 9/16/08 have been fully considered but they are not persuasive.

Regarding applicant's argument that none of Beaven, Ushiro or Kuwata teaches any of the features of the amended claims, examiner disagrees. Since applicant's lack specific arguments, the assertion above is disproved in the following rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

- 1) Claims 1, 2, 9, 10, 14, 15, 19, 27, 28, 30, 31, 33, 34 and 36 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 7,149,979 by Beaven et al.
- 2) Regarding claims 1 and 9, Beaven teaches a method of imaging transparency sheet media, comprising: detecting a transparency media designation associated with an electronic document file (column 4, lines 55-56); determining a mirror imaging selection for the electronic document file in response to detecting the transparency media designation (column 4, line 57), including prompting a user of the mirror imaging

Art Unit: 2625

selection and receiving in response thereto input designating mirror imaging of the electronic document file (column 4, line 65 – column 5, line 1; user has option to keep or change mirror image status, if mirror image is OK'd by the user then it is thereby "designated"); deriving an electronic mirror image corresponding to the electronic document file in accordance with the user input of the mirror imaging status (column 4, lines 59-60; if a mirror image document is an option and printed it is inherent that it is at some point "derived"); and forming a mirror image on a sheet of transparency sheet media in accordance with the electronic mirror image (column 4, lines 35-39).

3) Regarding claims 2, 15, 27 and 34, Beaven teaches the method of claim 1, and further comprising receiving the electronic document file from a user computer (figure 1; column 4, lines 19-24).

4) Regarding claims 10, 19, 31 and 36, Beaven teaches the computer-accessible storage media of claim 9, and wherein the computer-accessible storage media includes one of a compact disk, a magnetic disk, or a solid state memory (column 5, lines 57-67).

5) Regarding claim 14, Beaven teaches an imaging apparatus, comprising: an imaging engine configured to form images on a sheet media; and a controller coupled in controlling relationship with the imaging engine, the controller including a processor and a computer-accessible storage media, the computer-accessible storage media including an executable program code (column 4, lines 3-7; figure 1; driver operation can be in the printer), the program code configured to cause the processor to: detect a transparency media designation associated with an electronic document file (column 4, lines 55-56); prompt a user for a mirror imaging selection for the electronic document

Art Unit: 2625

file in response to detecting the transparency media designation, and receive in response thereto user input designating mirror imaging of the electronic document file (column 4, line 65 – column 5, line 1; user has option to keep or change mirror image status, if mirror image is OK'd by the user then it is thereby "designated"); derive an electronic mirror image of the electronic document file in accordance with the user input of the mirror imaging selection (column 4, lines 59-60; if a mirror image document is an option and printed it is inherent that it is at some point "derived"); and control the imaging engine to form a mirror image on a transparency sheet media in accordance with the electronic mirror image (column 4, lines 35-39).

6) Regarding claims 27, 30 and 33, Beaven teaches a method of imaging transparency sheet media, comprising: detecting a transparency media designation of an electronic document file (column 4, lines 55-56); determining a mirror imaging selection for the electronic document file in response to detecting the transparency media designation, including detecting an automatic mirror imaging designation for the electronic document file as the mirror imaging selection (column 4, line 45-49 and 57; mirror image function is set automatically in response to transparency selection); deriving an electronic mirror image of the electronic document file in accordance with the automatic mirror imaging designation (column 4, lines 59-60; if a mirror image document is an option and printed it is inherent that it is at some point "derived"); and forming a mirror image on a sheet of transparency sheet media in accordance with the electronic mirror image (column 4, lines 35-39).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7) Claims 3, 16, 20, 29, 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 7,149,979 by Beaven et al., and further in view of U.S. patent 4,891,517 by Ushiro et al.

8) Regarding claims 3, 16, 29 and 35, Beaven does not specifically teach the method of claim 1, and further comprising receiving the electronic document file from an optical scanner.

Ushiro teaches the method of claim 1, and further comprising receiving the electronic document file from an optical scanner (column 4, lines 44-47).

Beaven and Ushiro are combinable because they are both in the transparency recording field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Beaven and Ushiro to add receiving a document from a scanner. The motivation for doing so would have been to obtain data from an original (column 4, lines 44-47). Therefore it would have been obvious to combine Beaven and Ushiro to obtain the invention as specified by claims 3, 16, 29 and 35.

Art Unit: 2625

9) Regarding claims 20 and 37, Beaven does not specifically teach the apparatus of claim 14, and wherein the imaging engine is defined by one of a laser imaging engine, an inkjet imaging engine, or a thermal imaging engine.

Ushiro teaches the apparatus of claim 14, and wherein the imaging engine is defined by one of a laser imaging engine, an inkjet imaging engine, or a thermal imaging engine (column 5, line 3).

Beaven and Ushiro are combinable because they are both in the transparency recording field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Beaven and Ushiro to add a thermal print engine. The motivation for doing so would have been for "recording the image signals (column 4, line 48). Therefore it would have been obvious to combine Beaven and Ushiro to obtain the invention as specified by claims 20 and 37.

10) Claims 13 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 7,149,979 by Beaven et al., and further in view of U.S. patent 7,315,389 by Kuwata et al.

11) Regarding claims 13 and 32, Beaven does not specifically teach the computer-accessible storage media of claim 9, and wherein the program code is further configured such that deriving the electronic mirror image includes transposing imaging information within the electronic document file about a predetermined line of symmetry.

Kuwata teaches the computer-accessible storage media of claim 9, and wherein the program code is further configured such that deriving the electronic mirror image includes transposing imaging information within the electronic document file about a predetermined line of symmetry (column 10, lines 61-64; column 22, lines 36-45; mirroring is by definition transposing across a line of symmetry).

Beaven and Kuwata are combinable because they are both in the image recording field of endeavor.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Beaven and Kuwata to add mirroring in a file. The motivation for doing so would have been to obtain a mirrored image file (column 10, lines 61-64). Therefore it would have been obvious to combine Beaven and Kuwata to obtain the invention as specified by claims 13 and 32.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 2625

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BENJAMIN O. DULANEY whose telephone number is (571)272-2874. The examiner can normally be reached on Monday - Friday (10am - 6pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Benjamin O Dulaney/

Application/Control Number: 10/623,746

Page 9

Art Unit: 2625

Examiner, Art Unit 2625

/David K Moore/

Supervisory Patent Examiner, Art Unit 2625